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1631

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Skolnick et al.
Serial No. : 09/322,067
Filed : May 27, 1999
Title : METHODS AND SYSTEMS FOR PREDICTING PROTEIN FUNCTION

Art Unit : 1631
Examiner : M. Borin

MAIL STOP PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO WITHDRAW NOTICE OF ABANDONMENT

Under 37 CFR §§1.8(b) and 1.181, applicant hereby petitions to withdraw the Notice of Abandonment mailed July 26, 2004 (copy enclosed). The application was abandoned under 37 CFR §1.135 for failure to respond to the Restriction Requirement mailed March 5, 2003.

The undersigned, applicant's attorney of record, first became aware of the abandonment on July 28, 2004, upon receipt of the Notice of Abandonment and submits that this petition to withdraw the Notice is being promptly submitted as required by 37 CFR §1.8(b)(1).

The following documents are submitted under 37 CFR §1.8(b)(2) as proof that a Response was timely filed on September 5, 2003:

1. A copy of the response to the Restriction Requirement, including an executed certificate of mailing signed by Norman Green on September 5, 2003;
2. A copy of the Petition for Extension of Time, including an executed certificate of mailing signed by Norman Green on September 5, 2003, which extended the period for responding to the Restriction Requirement for three (3) months, to and including September 5, 2003;

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

August 2, 2004

Date of Deposit

Signature

Teri Barnett

Typed or Printed Name of Person Signing Certificate

Applicant : Skolnick et al.
Serial No. : 09/322,067
Filed : May 27, 1999
Page : 2 of 2

Attorney's Docket No.: 10886-047001 / TSRI
65401/SCR

3. A copy of the check dated September 5, 2003 and postcard dated September 5, 2003 that were included with the response and Petition for Extension of Time; and

4. A copy of the cancelled check and postcard stamped received by the PTO Mailroom on September 8, 2003.

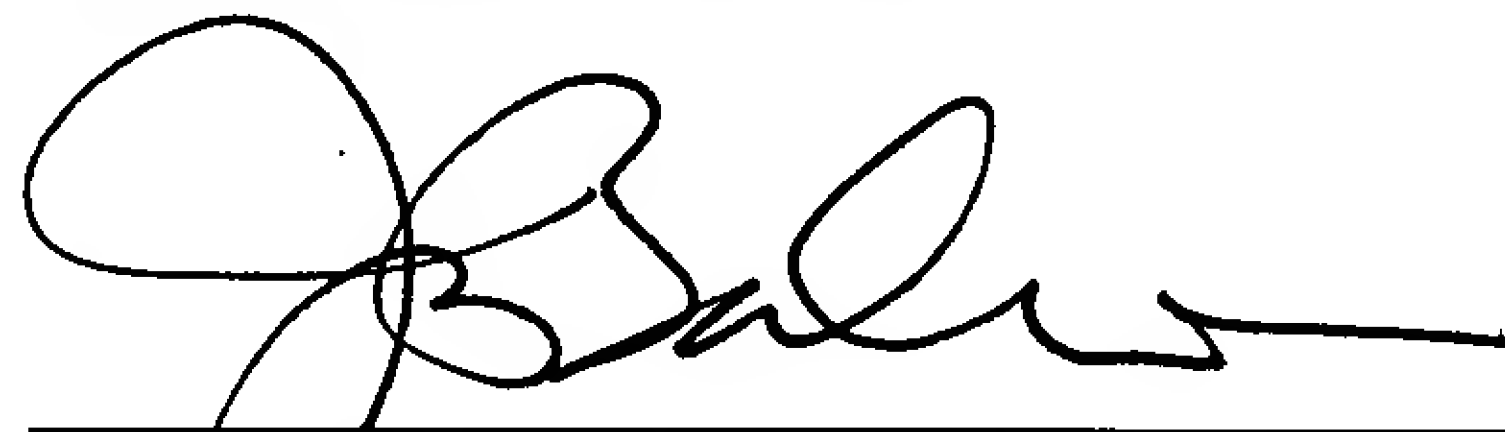
Applicant submits that the response to the Restriction Requirement was timely filed and requests that the Notice of Abandonment be withdrawn.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: _____

8/2/04



Joseph R. Baker, Jr.
Reg. No. 40,900

Fish & Richardson P.C.
PTO Customer No. 20985
12390 El Camino Real
San Diego, California 92130
Telephone: (858) 678-5070
Facsimile: (858) 678-5099

A circular black ink stamp from the Patent & Trademark Office. The text "OIP" is at the top, "AUG 05 2004" is in the center, and "PATENT & TRADEMARK OFFICE" is at the bottom. The date is stamped in a larger, bolder font than the surrounding text.

FISH & RICHARDSON P.C. 168885

225 Franklin Street
Boston, Massachusetts
02110-2804

C

PAY Nine hundred eighty five dollars DOLLARS

TO THE ORDER OF	DATE	AMOUNT
COMMISSIONER OF PATENTS AND TRADEMARKS	09/05/03	\$985.00

10886-047001 nzy

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52-153/112

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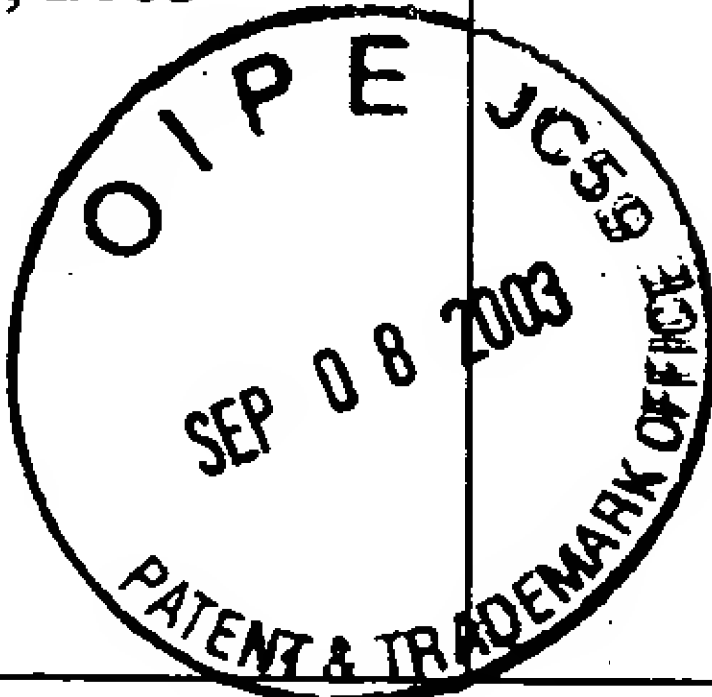


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SEP 15 2003

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SAN DIEGO

Attorney's Docket No. 10886-047001	Express Mail Label No.	Filing Date September 5, 2003	For PTO Use Only <i>Do Not Mark in This Area</i>
Application No. 09/322,067	Filing Date May 27, 1999	Attorney/Secretary Init GPE/jar	
Title of the Invention METHODS AND SYSTEMS FOR PREDICTING PROTEIN FUNCTION			
Applicant Skolnick et al.			
Client Reference No. TSRI 65401/SCR			
Enclosures · Transmittal Letter w/ Petition for 3 months Extension of Time (1 page) · Response to Restriction Requirement dated March 5, 2003 (4 pages) · Check in the amount of \$985.00			





Attorney's Docket No. 10886-047001	Express Mail Label No.	Mailing Date September 5, 2003	For PTO Use Only <i>Do Not Mark in This Area</i>
Application No. 09/322,067	Filing Date May 27, 1999	Attorney/Secretary Init GPE/jar	
Title of the Invention METHODS AND SYSTEMS FOR PREDICTING PROTEIN FUNCTION			
Applicant Skolnick et al.			
Client Reference No. TSRI 65401/SCR			
Enclosures · Transmittal Letter w/ Petition for 3 months Extension of Time (1 page) · Response to Restriction Requirement dated March 5, 2003 (4 pages) · Check in the amount of \$985.00			

FR FISH & RICHARDSON P.C.

168885

225 Franklin Street
Boston, Massachusetts
02110-2804

C

PAY Nine hundred eighty five dollars **DOLLARS**

TO THE ORDER OF	DATE	AMOUNT
COMMISSIONER OF PATENTS AND TRADEMARKS	09/05/03	\$985.00 .

10886-047001 nzg

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52-153/112

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www.fleet.com
South Portland, ME

BY 

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Skolnick et al. Art Unit : 1631
Serial No. : 09/322,067 Examiner : M. Borin
Filed : May 27, 1999
Title : METHODS AND SYSTEMS FOR PREDICTING PROTEIN FUNCTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER AND PETITION FOR AUTOMATIC EXTENSION

Correspondence relating to this application is enclosed. The required fees are computed below. Please apply any charges not covered, or any credits, to Deposit Account No. 06-1050.

Applicant hereby petitions under 37 C.F.R. §1.136 for a 5 month extension of time. \$985

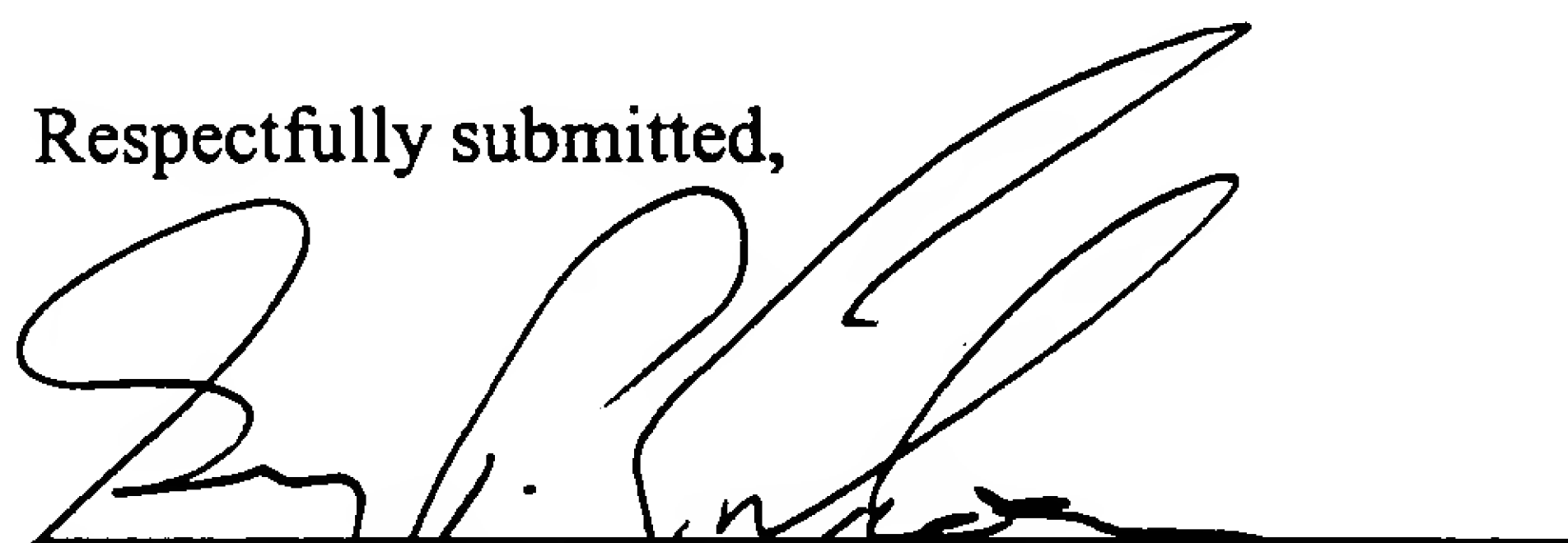
TOTAL FEE DUE \$985

A check for \$985 is attached.

Respectfully submitted,

Date:

Sept. 05, 2003


Gregory P. Einhorn
Reg. No. 38,440

Fish & Richardson P.C.
4350 La Jolla Village Drive, Suite 500
San Diego, California 92122
Telephone: (858) 678-5070
Facsimile: (858) 678-5099

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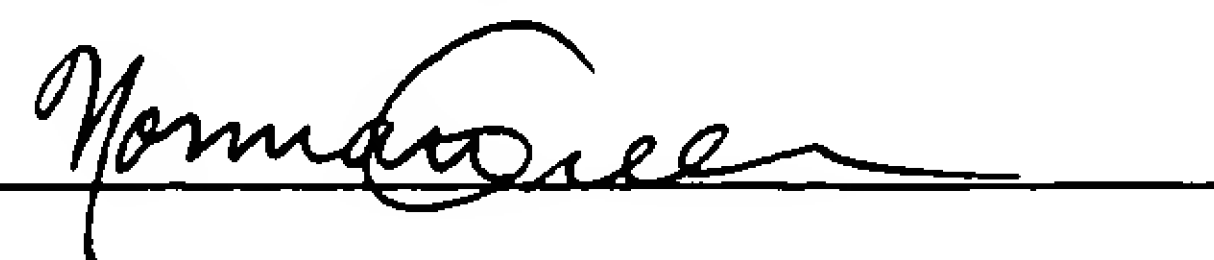
CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

September 5, 2003

Date of Deposit

Signature



Norman Green

Typed or Printed Name of Person Signing Certificate



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Skolnick et al. Art Unit : 1631
Serial No. : 09/322,067 Examiner : Dr. Michael Borin
Filed : May 27, 1999
Title : METHODS AND SYSTEMS FOR PREDICTING PROTEIN FUNCTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

Responsive to the Election/Restriction Requirement Office Action mailed March 05, 2003, Applicants respectfully request entry of the amendment and consideration of the remarks set forth herein. A response to the Office Action was originally due June 05, 2003. Applicants submit herewith a Petition for Extension of Time to extend the time to reply to this Office Action for three months to September 5, 2003. Accordingly, this Response is timely filed.

The following documents are enclosed herewith:

- Transmittal letter, petition to extend time 3 months, and check;
- Postcard.

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

September 5, 2003

Date of Deposit

Signature

Norman Green

Typed or Printed Name of Person Signing Certificate

REMARKS

Status of the Claims

Pending claims

Claims 3, 5 to 10, 12 to 14, 16 to 20, 22, 45, 46, 48 to 50, 52 to 54, 56, 58 and 59 are pending.

Applicants last response was a Request for continued examination (RCE) under 37 C.F.R. §1.114, submitted December 17, 2003. In that response, new claims 61 to 116 were added, and claims 2, 4, 11, 44, 47, 51, 55, 57 and 60 were canceled, without prejudice.

The Restriction Requirement

This is a second restriction requirement. The first restriction requirement was issued on November 08, 1999. In the first restriction requirement, the Patent Office alleged that the pending claims of the application were directed to four separate and distinct inventions under 35 U.S.C. §121. In Applicants' response of January 24, 2000, Group I, drawn to a functional site descriptor, was elected, with traverse. In that response, Applicants set forth distinct and specific errors in the restriction requirement and reasons for the Patent Office to reconsider and withdraw, in part, the restriction requirement. Accordingly, Applicants preserved their right to petition the restriction to the Group Director under 37 CFR §1.144; see also MPEP §818.03(c); pg 800-60, 8th Edition, August 2001.

In this second restriction requirement, the Patent Office alleged that the pending claims of the application were directed to three separate and distinct inventions under 35 U.S.C. §121, as follows, referring only to independent claims:

Group I: claims 53, 59 and 20, drawn to a descriptor of a functional site of a protein;

Group II: claims 45, 54, 56, 58, 92, 105, 106, drawn to methods of creating or defining or determining of a descriptor of a functional site of a protein.

Group III: claims 53, 59 and 20, drawn to a computer system.

The Election

In response to the Restriction Requirement, Applicants re-elect Group I, drawn to a descriptor of a functional site of a protein (or, as worded in the first restriction requirement, drawn to a functional site descriptor).

Applicants respectfully request that, after the elected product claims (descriptor of a functional site of a protein) have been found to be allowable, all withdrawn process (methods) claims which depend from or otherwise include all of the limitations of the allowed product claims be rejoined. MPEP §821.04; pg 800-63, 8th Edition, August 2001; In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995); In re Brouwer, 37 USPQ2d 1663 (Fed. Cir. 1995); 1184 OG 86, 3/26/96.

Reasons to reconsider and withdraw restriction requirement

Applicants respectfully request the Patent Office reconsider and, in part, withdraw the restriction requirement for the following reasons:

Applicants incorporate herein their response of January 24, 2000, electing Group I, drawn to a functional site descriptor, where they set forth distinct and specific errors in the restriction requirement and reasons for the Patent Office to reconsider and withdraw, in part, the restriction requirement, to preserve their right to petition the restriction to the Group Director under 37 CFR §1.144.

Furthermore, Applicants respectfully aver that after a complete search directed to the claimed functional site descriptors of Group I, it would not be an undue burden for the Patent Office to also do a complete search for corresponding methods of creating or defining or determining of a descriptor of a functional site of a protein (functional site descriptors of the invention). Accordingly, Applicants respectfully request the Patent Office to rejoin all claims directed to functional site descriptors of the invention and methods of creating or defining or determining functional site descriptors of the invention into one restriction group.

Applicants respectfully aver that after a complete search directed to the claimed functional site descriptors of Group I, it would not be an undue burden for the Patent Office to also do a complete search for corresponding computer system comprising functional site descriptors of the invention. Accordingly, Applicants respectfully request the Patent Office to

Applicant : Skolnick et al.
Serial No. : 09/322,067
Filed : May 27, 1999
Page : 4 of 4

Attorney's Docket No.: 10886-047001 / TSRI
65401/SCR

rejoin all claims directed to functional site descriptors of the invention and computer systems comprising functional site descriptors of the invention into one restriction group.

It is believed that the all claims pending in this application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

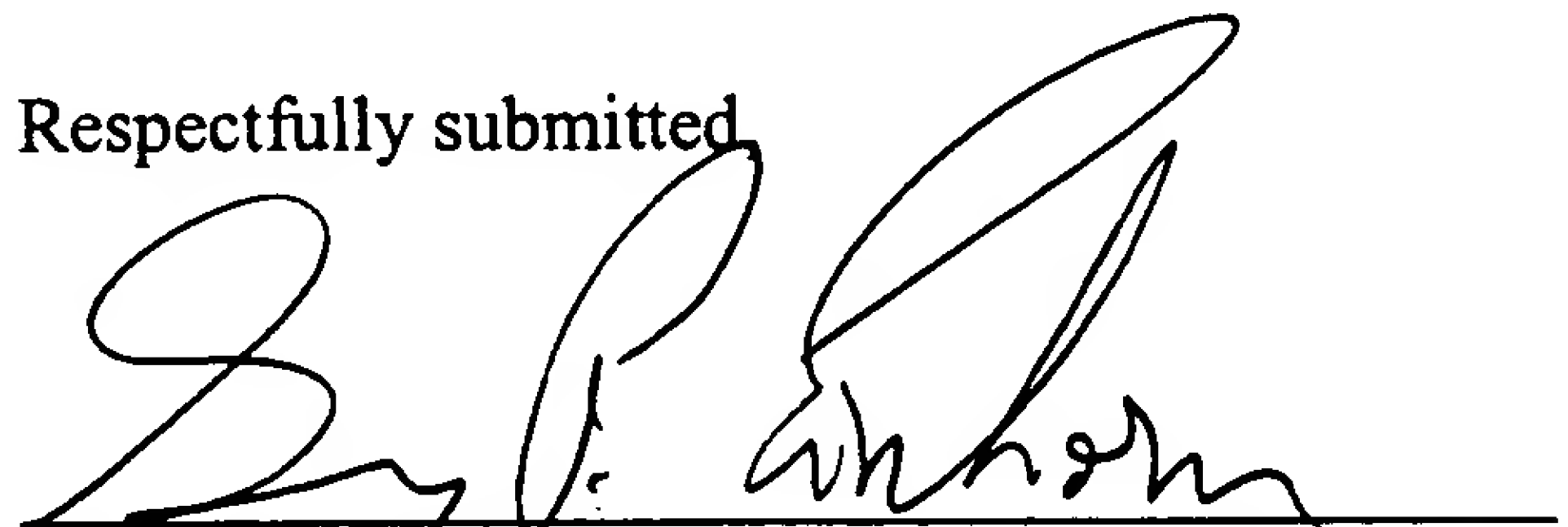
If an additional fee is required, the Commissioner is authorized to deduct such fee from the undersigned's Deposit Account No. 06-1050. Please credit any overpayment to the above-noted Deposit Account.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858 678 5070.

Date:

Sept. 5, 2003

Respectfully submitted



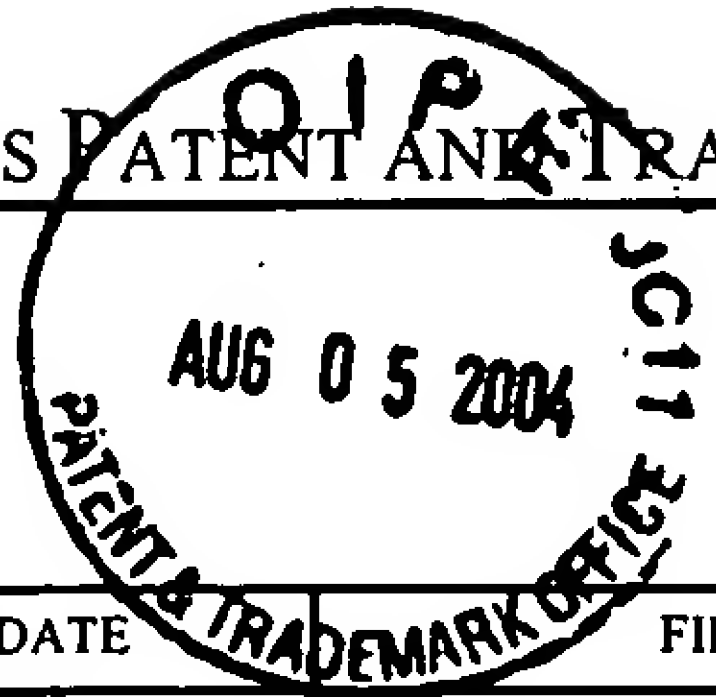
Gregory P. Einhorn
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Facsimile: (858) 678-5099

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/322,067	05/27/1999	JEFFREY SKOLNICK	10886/047001	7470

20985 7590 07/26/2004

FISH & RICHARDSON, PC
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JUL 28 2004

FISH & RICHARDSON, P.C.
SAN DIEGO

EXAMINER

BORIN, MICHAEL L

ART UNIT PAPER NUMBER

1631

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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JUL 28 2004

FISH & RICHARDSON, P.C.
SAN DIEGO



Notice of Abandonment

Application No.

09/322,067

Examiner

Michael Borin

Applicant(s)

SKOLNICK ET AL.

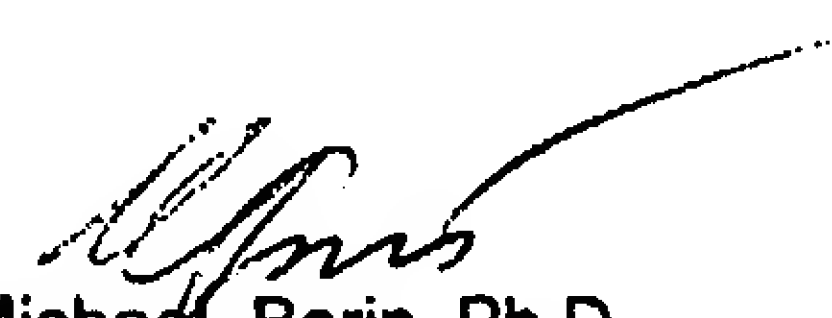
Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 02 March 2003.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:


Michael Borin, Ph.D.
Primary Examiner
Art Unit: 1631

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.